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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,058	05/18/1999	MICHAEL V. LEMAN	MICE-0026-US	4641

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EXAMINER

EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 10/01/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,058

Applicant(s)

LEMAN, MICHAEL V.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-33 and 35-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-30,32,33,35-37 and 39-41 is/are rejected.
- 7) ☒ Claim(s) 31 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 28-30, 32, 33, 35-37, 39-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitachi LTD ("Hitachi"), JP 05-197444 in view of Mitsubishi Electric Corporation ("Mitsubishi"), JP 02-129689 and further in view of Matsushita Electric IND CO LTD, ("Matsushita"), JP 06-161636.

With respect to **claims 28 and 35** Hitachi discloses a computer system and method comprising a computer (portable information machine and equipment 3 in FIG. 3) having a first display (4), a second display (5), a base unit containing a keyboard (6), the unit is separate from the first and second displays; providing the first display to face in a first direction; providing a second display to face in substantially first direction (as in the method of FIG. 5); configuring the keyboard to receive an input; and hingedly connecting the first display to the base unit (FIGS. 3, 5; paragraphs [0011] - [0013]).

Hitachi does not disclose, however, that the first display can be also configured to receive a pen input.

Mitsubishi teaches two displays computer system having two displays, (5) and (6), and a separate unit containing a keyboard (3), wherein the first display (6) is provided with a touch tablet for inputting position information (see abstract, FIGS.2 and

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5), and Matsushita teaches that the tablet is used to accept a pen input (FIG. 3; paragraphs [0021] - [0023]).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to provide one of the displays in Hitachi with the tablet, being motivated by Mitsubishi, because it would add an important feature such as entering position information directly onto display by a pen, which would allow in turn to use a pen to activate various user interface elements, such as shown on the display (6) in FIG. 5 of Mitsubishi, or to input handwritten or drawing information.

As to **claims 29 and 37**, Hitachi further teaches hinge connection between the two displays (hinge 12 in FIG. 2).

As to **claims 30 and 41**, both Hitachi (in FIG. 3) and Mitsubishi (in FIG. 5) show folding of the first display onto the second display so that both displays remain exposed.

As to **claim 32**, Mitsubishi shows that the second display (5) is displaying the images while the first display (6) is provided with the tablet for receiving adaptable according to Matsushita to receive a pen input.

As to **claim 33**, the display (5) in Mitsubishi is conventional display while the display (6) can be a pen-based display.

As to **claim 36**, the portable information unit 3 of Hitachi has a structure as shown in FIG. 1 and thus constitute a laptop computer.

As to **claims 39 and 40**, the computer system is adapted to receive the input from pen and from the keyboard.

Allowable Subject Matter

3. **Claims 31 and 38** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the references, either singly or in combination, teach or suggest the computer system, wherein the first display and the second display are foldable onto the keyboard to provide a pen-based tablet arrangement, in which the second display remains exposed and is adapted to receive the pen-based input.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Hitachi reference fails to disclose configuring a first display to receive a pen-based input, or a second display adapted to receive a pen-based input. The examiner recognized that fact in the rejection and therefore the rejection of claims 28 and 35 are based not on a single reference but rather on combination thereof.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hitachi teaches everything except for the adapting display for a pen-based input. But pen-base displays are well

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known in the art and the examiner recites Mitsubishi reference only to demonstrate that common knowledge. As to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The rejection is maintained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (9:00 a.m. - 4:00 p.m.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on **(703) 305-4709**.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is **(703) 306-0377**.

AE

Alexander Eisen
September 24, 2003



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600